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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/046,784 03/23/98 CARTER

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EXAMINER

TM01/1207

THE HECKER LAW GROUP
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DE LA TORRE, C

ART UNIT

PAPER NUMBER

2173

DATE MAILED:

12/07/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/046,784

Applicant(s)
Carter

Examiner
Crescelle Dela Torre

Group Art Unit
2173



- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- ☒ Claim(s) 1-23 _____ is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-23 _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2173

DETAILED ACTION

1. This action is responsive to communications: CPA Request, filed on 9/7/00, and Preliminary Amendment, filed on 10/30/00.

This action is non-final.

2. Claims 1 - 23 are pending in this application. Claims 1, 7, 12, 17, and 23 are independent claims. In the Preliminary Amendment, filed on 10/30/00, claims 1, 7, 12, 17, and 23 were amended.

3. The present title of the invention is "Method and Apparatus for Selecting Attachments" as filed originally.

Continued Prosecution Application

4. The request filed on 9/7/00 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/046,784 is acceptable and a CPA has been established. An action on the CPA follows.

Specification

Art Unit: 2173

5. The description portion of this application contains a computer program listing consisting of more than ten (10) pages. In accordance with 37 CFR 1.96(c), a computer program listing printout of more than ten pages must be submitted as a "microfiche appendix" conforming to the standards set forth in 37 CFR 1.96(c)(2) and must be appropriately referenced in the specification (see 37 CFR 1.77(a)(6)). Accordingly, applicant is required to cancel the computer program listing appearing in the specification on pages 37 - 58, file a "microfiche appendix" in compliance with 37 CFR 1.96© and insert an appropriate reference to the newly added "microfiche appendix" at the beginning of the specification.

Claim Rejections - 35 U.S.C. § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 - 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borman et al. (U.S. patent 5,890,172) in view of Kelley (U.S. patent 6,078,921).

As per claim 1, Borman et al., hereinafter Borman, teach the following subject matter:

Art Unit: 2173

a browsing mechanism, with browser interface 400, at Figs. 5A - 5C, and col. 7, lines 52 - 53, configured to render a current data resource, i.e., a file retrieved by the browser, and to navigate through plural data resources, using the Back 412, Forward, and Home 414 buttons; and an attachment mechanism, using jumper window 300, at Fig. 3, configured to retrieve an attachment from the browser in response to a user event, i.e., by a selecting a hot-link with a mouse, at col. 6, lines 55 - 60, the attachment associated with the current data resource, since the "hot-links are extracted from a file initially retrieved by the browser".

Regarding claim 1, Borman describes that in another embodiment, "the user will be able to invoke the product from within their electronic e-mail box simply by double-clicking on attached files" at col. 12, lines 62 - 64. However, Borman does not specifically teach attaching the attachment to an e-mail message. Nor does Borman specifically teach a selection mechanism to select a portion of a current data resource.

On the other hand, Kelley teaches a method for selecting a portion of a current data resource in response to user input, at Fig. 6C, and col. 7, lines 16 - 30, which results in a "single file that can be used to store and view multi-part files" and create a "single attachment of multi-part files in an e-mail system", at col. 7, lines 38 - 41. For example, Kelley teaches that the combined file "can be coupled to a e-mail message" at col. 7, lines 41 - 42.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to attach a portion of a current data resource to an e-mail message as taught by Kelley

Art Unit: 2173

in the invention of Borman because it allows a user to “convert multi-part files into a single file for use and transfer” at col. 4, lines 19 - 20.

Borman teaches that the attachment comprises a resource locator [claim 2] at col. 7, lines 62 - 63, or source data [claim 3] associated with the current data resource at col. 13, lines 32 - 38.

Kelley teaches selecting an attachment type [claim 4] at Fig. 6C, and col. 7, lines 34 - 35.

Furthermore, Borman teaches that the attachment mechanism comprises a button [claim 5] with refresh/update button 326, at Fig. 3, and col. 7, lines 17 - 19. As to claim 6, Borman teaches navigating to a first data resource, in browser window 406, using a resource locator, with hot-link 580, in a second data resource, in jumper window 300, all at Fig. 6.

Regarding claims 7 - 11, they are similar to claims 1, 4, 2, 3, and 6. Claims 12 - 16 correspond respectively to claims 7 - 11; while claims 17 - 19, 21, and 23 correspond to claims 1 - 3, 6, and 1.

As per claim 20, the first part is similar to claim 4, while the second part is taught by Borman with site window 404, at col. 7, line 32, and at Fig. 5A, which allows a user to select the property value by entering the site location.

As to claim 22, Borman teaches the following:

a stack configured to contain resource locators of navigated data resources, with history creation process 712, at Fig. 7, and col. 9, lines 40 - 42; and

Art Unit: 2173

one or more methods configured to browse navigated data by stepping forward or backward within the stack, at col. 9, lines 43 - 56.

Response to Arguments

8. Applicant's arguments with respect to claims 1 - 23 have been considered but are moot in view of the new ground(s) of rejection.

Examiner agrees that the combination of Borman and Kuzma do not specifically teach selecting a portion of a data resource. Rather, as noted by applicant, Kuzma teaches an attachment reference for an entire attachment file. Instead, the Kelley reference was used in combination with Borman to teach selecting a portion of a data resource, at Fig. 6C, and col. 7, lines 16 - 30.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Keller et al. (U.S. patent 5,418,908) describe the inclusion of place marks in an e-mail system.

Higley (U.S. patent 5,790,793) teaches sending and receiving URLs in an e-mail system.

Responses

Art Unit: 2173

10. Responses to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231. If applicant desires to fax a response, (703) 308-9051 may be used for formal communications or (703) 308-6606 for informal or draft communications.

Please label "PROPOSED" or "DRAFT" for informal facsimile communications. For after final responses, please label "AFTER FINAL" or "EXPEDITED PROCEDURE" on the document.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Inquiries

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Crescelle dela Torre whose telephone number is (703) 305-9782. The examiner can normally be reached on Mondays-Thursdays from 8:30 am to 4:00 pm, and on alternating Fridays from 8:30 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached at (703) 308-3116.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

C. dela Torre
CRESCELLE N. DELA TORRE :
PRIMARY EXAMINER
12/6/00